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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,776	12/12/2003	Mechthild Rieping	7601/80921	9536

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LAW OFFICE OF MICHAEL A. SANZO, LLC
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ROCKVILLE, MD 20855

EXAMINER

STEADMAN, DAVID J

ART UNIT	PAPER NUMBER
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1656

MAIL DATE	DELIVERY MODE
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06/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/733,776

Applicant(s)

RIEPING, MECHTHILD

Examiner

David J. Steadman

Art Unit

1656

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 27 April 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 112, second paragraph.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 35-37.
Claim(s) objected to: 26 and 27.
Claim(s) rejected: 11, 14, 15, 19, 20, 22, 23, 25 and 28-34.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.


David J. Steadman, Ph.D.
Primary Examiner
Art Unit: 1656

Continuation of 11. does NOT place the application in condition for allowance because: The request for reconsideration in the response filed on 4/13/07 is acknowledged. Applicant's arguments filed on 4/13/07 have been fully considered, however, the claims are not in condition for allowance for reasons that follow. The rejection of claim(s) 11, 14-15, 19-20, 22-23, 25, and 28-34 under 35 U.S.C. 103(a) as being unpatentable over Volz (Protein Sci 8:2428-2437, 1999; cited in the IDS filed on 11/18/2004) in view of Enos-Berlage et al. (J. Bacteriol 180:6519-6528, 1998; cited in the IDS filed on 11/18/2004) is maintained for the reasons of record and the reasons stated below. In response, applicant argues the term "isolate" requires that at least one amino acid be purified to some degree and that one would need to recognize that the amino acid was being produced and perform an act to separate it from other components. According to applicant, the examiner's inherency rationale requires the reference to isolate one or more amino acids, however, it is not a necessary consequence of the method disclosed in the prior art that an amino acid is necessarily isolated. As such, applicant argues the rejection is improper. Applicant's argument is not found persuasive. The examiner does not disagree with applicant's assertion that "this term ["isolate"] requires that at least one amino acid be purified to some degree. In this case, the term "isolate" is a term of degree and the examiner knows of no art-recognized degree of purity associated with the term "isolate." As such, the examiner has referred to the specification for the intended meaning of the term "isolate." "[T]he specification 'is always highly relevant to the claim construction analysis. Usually it is dispositive; it is the best single guide to the meaning of a disputed term.'" Phillips v. AWH Corp., 415 F.3d 1303, 1315, 75 USPQ2d 1321, 1327 (Fed. Cir. 2005). According to the specification at p. 4, lines 6-9, "isolation of the desired L-amino acid, constituents of the fermentation broth and/or the biomass in its entirety or portions (>0 to 100 %) thereof optionally remaining in the product." See also original claim 2, which recites, "[p]rocess according to claim 1, wherein the desired L-amino acid is isolated, constituents of the fermentation broth and/or the biomass in its entirety or portions (>0 to 100 %) thereof optionally remaining in the product." Thus, according to the specification, "isolate" does not require purification to homogeneity, but allows for "constituents of the fermentation broth and/or the biomass in its entirety or portions (>0 to 100%) thereof optionally remaining in the product." As such, it would appear that a broad, but reasonable interpretation of "isolating said L-amino acid" in claim 11 includes, e.g., removing cell debris, i.e., unlysed cells and cell membranes, from a whole cell lysate, isolating an aliquot of the culture, and/or centrifuging the culture to isolate the liquid portion of the medium from whole cells and removing the liquid portion from the whole cells, steps that are included in the method of the prior art. This interpretation would appear to agree with the specification's disclosure as noted above. Even assuming arguendo the intended definition of "isolating" requires at least one amino acid to be purified to some degree, it is noted that by practicing the method as suggested by the prior art to, e.g., removing cell debris and unlysed cells to obtain a cell-free extract, one would necessarily be purifying the L-amino acid "to some degree." At least for these reasons, the claimed invention would have been obvious at the time of the invention.